

REMARKS

Claims 1-34 are pending in the application. Claims 14-28 have been withdrawn. Claim 1 has been amended to correct grammatical and formal errors. Care has been taken to avoid the introduction of new matter.

In the Office Action, claims 1, 4-13, and 29-33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,745,900 (Burrows) in view of the article by Forbes J. Burkowski entitled "Retrieval Performance of a Distributed Text Database Utilizing a Parallel Processor Document Server" (Burkowski). Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Burrows in view of Burkowski and further in view of U.S. Patent Application Publication 2001/0025287 (Okabe). Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Burrows in view of Burkowski and further in view of U.S. Patent Application Publication 2001/0011350 (Zabetian). Claim 34 was rejected under 35 U.S.C. §103(a) as being unpatentable over Burrows in view of Burkowski and further in view of U.S. Patent 5,444,840 (Froessl). These rejections are respectfully traversed. Applicants respectfully request reconsideration and allowance of the claims in view of the following arguments.

Regarding the obviousness rejection of independent claims 1, 13 and 29 based on Burrows and Burkowski, it is contended in the Office Action that it would have been obvious to modify the system of Burrows to include Burkowski's teaching of equal distribution of documents among data storage nodes to yield the claimed inventions. Applicants disagree, and submit that one skilled in the art would not have been motivated to combine Burrows and Burkowski in the manner suggested in the Office Action to yield the inventions of claims 1, 13 and 29.

Burrows teaches a methodology for indexing records, such as web pages or documents on a local or wide area network. Burrows does not relate to storage or distribution of the records it indexes. Rather, Burrows works on (i.e., indexes) records that reside in a preexisting system such as the World Wide Web, and does not teach or even suggest record distribution techniques. Thus, as admitted in the Office Action, Burrows does not disclose the claimed step of distributing a plurality of de-duplicated and fingerprinted native documents and extracted data equally amongst a plurality of nodes of a computer system.

Because Burrows does not teach distributing documents in any particular way, a skilled artisan would not have been motivated to modify it to incorporate the document distribution scheme of Burkowski. The Office Action contends that one of ordinary skill in the art would have been motivated to make such a combination with reasonable expectation of success. However, it is well-established that the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916, F.2d 680 (Fed.Cir. 1990).

In the present case, neither reference contains an objective teaching that would have motivated one skilled in the art to combine them as suggested by the Examiner to yield the invention of claim 1, claim 13 or claim 29. Burrows does not relate to distributing fingerprinted and de-duplicated documents, and does not contain any teaching or suggestion that document distribution can or should be improved. Burkowski does not relate to indexing and/or de-duplication of documents, and does not teach or suggest that indexing and/or elimination of duplicate documents should be performed. It is contended in the Office Action at page 4 that it would have been obvious to combine Burrows and Burkowski to increase performance of text retrieval. However, there is no teaching or suggestion in Burrows or Burkowski that this would be desirable.

Burkowski relates to a text retrieval system, and teaches that its scheme of workload allocation across a plurality of server nodes is a desirable part of that system to improve search response. However, Burkowski does not relate to indexing or de-duplicating documents, as does Burrows, and does not suggest that its uniformly distributed server nodes have anything to do with indexing or de-duplicating. Burkowski's server nodes having equal workload allocation may be desirable in some systems, due to the specific needs of its users, but Burrows does not teach or suggest a need for the equal workload allocation taught by Burkowski in *its* system. Providing such allocation would require major and fundamental changes to any of the record storage systems taught by Burrows. Therefore, absent a teaching of an advantage of equal workload allocation in a system like Burrows', a skilled artisan would not have been motivated to combine Burrows and Burkowski as suggested in the Office Action to yield the invention of claim 1, claim 13 or claim 29.

Likewise, Burkowski does not teach any appreciation of indexing or de-duplicating documents as taught by Burrows. Absent a teaching of an advantage of indexing and/or de-duplication in a system like Burkowski's, a skilled artisan would not have been motivated to combine Burrows and Burkowski as suggested in the Office Action to yield the invention of claim 1, claim 13 or claim 29.

In summary, there is no objective teaching in either reference that would have motivated a skilled artisan to combine the teachings of Burrows and Burkowski to yield a system that de-duplicates documents and distributes them equally among a plurality of computer nodes, as claimed. Burrows lacks a teaching of an advantage of equal workload allocation in its system, and Burkowski lacks a teaching of an advantage of indexing and/or de-duplication in its system. Therefore, no combination of Burrows and Burkowski would render the invention of claims 1, 13 or 29 obvious.

Consequently, independent claims 1, 13 and 29 are patentable, as are claims 4-12 and 30-33, which depend from claims 1 and 29, respectively.

Regarding the obviousness rejection of dependent claim 2 based on Burrows, Burkowski and Okabe, and the obviousness rejection of dependent claim 3 based on Burrows, Burkowski and Zabetian, both claims 2 and 3 depend from claim 1. As discussed above, there is no objective teaching in Burrows or Burkowski that would have motivated one skilled in the art to combine Burrows and Burkowski to yield the invention of claim 1. Neither the additional cited Okabe nor Zabetian reference furnishes a motivation to combine Burrows and Burkowski to yield the invention of independent claim 1. Therefore, no Burrows/Burkowski/Okabe combination could render claim 2 obvious, and no Burrows/Burkowski/Zabetian combination, however made, could render claim 3 obvious.

Claims 2 and 3 are consequently patentable for the same reasons as their base claim 1.

Regarding the obviousness rejection of independent claim 34 based on Burrows, Burkowski and Froessler, this claim recites a system that stores de-duplicated fingerprinted documents substantially equally in number throughout a computer connected in a parallel cluster. As discussed above, there is no objective teaching in Burrows or Burkowski that would have motivated one skilled in the art to combine Burrows and Burkowski to yield a system that de-duplicates fingerprinted documents and stores them equally throughout a plurality of computer nodes, which are analogous to a “parallel cluster”. Thus, it would not have been obvious to combine Burrows and Burkowski to yield the invention of claim 34. The additional cited Froessler reference does not furnish a motivation to combine Burrows and Burkowski to yield the invention of independent claim 34. Therefore, no Burrows/Burkowski/Froessler combination, however made, could render claim 34 obvious.

Consequently, claim 34 is patentable.

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Reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. §103 are respectfully requested.

Accordingly, it is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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